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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,546	02/07/2002	Subhash Chandra Taneja	82373	7828

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NATH & ASSOCIATES
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WASHINGTON, DC 20005

EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,546

Applicant(s)

TANEJA ET AL.

Examiner

Laura L. Stockton, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-3, 7-19 and 21 are pending in the application.

Continued Prosecution Application

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on December 10, 2004 has been entered.

Election/Restrictions

The entire scope of the elected product invention of Group I (claims 1, 2 and 21) has been examined.

Claims 3 and 7-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse (claims 7-19 only) in Paper No. 6 (April 30, 2003).

Rejections made in the previous Office Action that do not appear below have been overcome. Therefore, arguments pertaining to these rejections will not be addressed.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raman et al. {U.S. Pat. 6,346,539}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim arylalkenoic acid heterocyclic amide compounds. Raman et al. teach arylalkenoic acid heterocyclic amide compounds that are structurally similar to the instant claimed compounds (column 3, lines 1-40; column 4, lines 38-57; and the "alterations to nitrogen substituent" and "alterations to the phenyl substituent" in columns 5-6, especially compounds 17

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and 20) that are useful in treating skin conditions (column 2, lines 17-64).

See in Raman et al., for example, the compounds of formula (I) at the top of column 3 wherein n is zero; R² and R³ together represent a carbon to carbon double bond; R¹ is an alkoxy group having from 1 to 3 carbon atoms; m is one and R⁶ represents a morpholino group (also see Applicants' compound vi in instant claim 2).

Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)

The difference between the compounds in the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP
§2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814

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(1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., treating skin conditions).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, skin conditions. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Response to Arguments

Applicants' arguments filed October 12, 2004 have been fully considered. Applicants requested that the scope of the examined compound claims be identified so

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that if the compounds are ever in condition for allowance, the method of use claims can be properly rejoined. In response, the entire scope of the elected product invention of Group I (claims 1, and 2), and now newly added claim 21, has been examined. Further, in accordance with M.P.E.P. §821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Applicants argue that: (1) the generic disclosure in Raman et al. fail to teach or suggest the specific subgenus and species claimed; (2) the Federal Circuit has repeatedly and consistently held that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness; and (3) in order to establish a *prima facie* case, the PTO must satisfy three requirements.

In response, Raman et al. do teach Applicants specific subgenus and would direct one skilled in the art toward the instant claimed products. See in Raman et al., for example, the compounds of formula (I) at the top of column 3 wherein n is zero; R^2 and R^3 together represent a carbon to carbon double bond; R^1 is an alkoxy group having from 1 to 3 carbon atoms; m is one and R^6 represents a morpholino group (also see Applicants' compound vi in instant claim 2).

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

These criteria for establishing a *prima facie* case of obviousness have been considered and applied in the instant application.

1. Determining the scope and contents of the prior art.

Applicants claim arylalkenoic acid heterocyclic amide compounds. Raman et al. teach arylalkenoic acid heterocyclic amide compounds that are structurally similar to the instant claimed compounds (column 3,

lines 1-40; and the "alterations to nitrogen substituent" and "alterations to the phenyl substituent" in columns 5-6) that are useful in treating skin conditions (column 2, lines 17-64).

2. Ascertaining the differences between the prior art and the claims at issue.

The difference between the compounds in the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

3. Resolving the level of ordinary skill in the pertinent art.

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar

compounds would possess similar activity (e.g., treating skin conditions).

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, skin conditions. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Applicants argue that in order to find such motivation or suggestion there should be reasonable likelihood that the claimed invention would have the properties disclosed in the prior art teachings. In response, there is no requirement that the prior art

must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness.

In re Dillon, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990).

Applicants argue that MPEP §2144.08 provides that in the case of a prior art reference disclosing a genus, the Office should make findings as to: (A) the structure of the disclosed prior art genus; (B) any physical or chemical properties and utilities; (C) the predictability of the technology; and (D) the number of species encompassed by the genus. Applicants allege that the Examiner has failed to make such findings and none of these factors are discussed in any Office Action.

In response, the Examiner disagrees. Each and every one of factors (A) - (D) have been discussed in the previous Office Actions. The Examiner identified that the genus of the prior art was disclosed in column 3,

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lines 1-40 {factor(A)}; that the products of the prior art are useful in treating skin conditions, column 2, lines 17-64 {factor (B)}; the predictability {factor (C)} and species {factor (D)} were also discussed in the rejection under the headings "*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*" and "*Determination of the scope and content of the prior art (MPEP §2141.01)*", respectively.

Applicants argue that Raman et al. do not teach or suggest the inventive compounds aside from a generic disclosure and in fact, Raman et al. teach away from the inventive compounds. Applicants' arguments have been considered but have not been found persuasive. It would appear that Applicants are arguing that if a rejection under 35 USC § 102 cannot be made, that it is unobvious and improper to make a rejection under 35 USC § 103, which is not the correct rationale that should be applied.

Applicants argue that MPEP §2144.08 makes clear that different utilities are a factor supporting nonobviousness. In response, MPEP §2144.08 (Rev. 2, May 2004, page 2100-150, bottom of second column) states that, "However, the prior art need not disclose a newly discovered property in order for there to be a *prima facie* case of obviousness" and cites *Dillon*.

Applicants argue: (1) the number of specie in the genus of Raman et al.; (2) the Office Action fails to make explicit findings on the similarities and differences between the closest disclosed prior art species or subgenus; and (3) the Examiner has cited no reference which teaches or suggests that compounds useful for treating skin conditions are also useful as spicy and pungent food additives.

All of Applicants' arguments have been considered but have not been found persuasive. Although the number of specie embraced by a genus is important, the specific species prepared by the prior art is compared

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to the instant claimed products. In the instant case, the preferred embodiments (column 4, lines 38-57) and the specie prepared by the prior art would lead on skilled in the art to the instant claimed genus and the morpholino containing species found in instant claim 2.

The similarities of the instant claimed compounds can be shown by the specie disclosed in the prior art. The closest prior art compound would be Compound 17 in columns 5-6. Further, only compounds are under examination in the instant application, not methods of use. There is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. In re Dillon, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990). Absent unexpected, unobvious and beneficial results of the instant claimed compounds over the compounds taught in Raman et al., the instant claimed compounds would have been suggested to one skilled in the art and

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therefore, would have been obvious to one skilled in the art.

Allowable Subject Matter

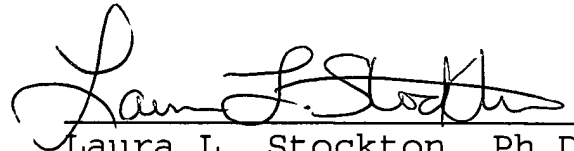
Claim 21 is allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

March 21, 2005